

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed January 30, 2004. Noted with appreciation is the indication that the pending subject matter would be allowable over the references of record by way of an Examiner suggested amendment. Applicant has attempted to comply with the Examiner's request in making a number of amendments to the pending claims. Applicant cancels Claims 20, 23, 32, 40, 51, 61, 68, and 77 without prejudice or disclaimer in order to advance prosecution in this case. The cancellation of these claims is not the result of any prior art reference, nor is it result of any deficiency in the corresponding specification. Applicant also amends Claims 1, 21, 22, 24-27, 31, 39, 44, 50, 52-53, 60, 64, and 76. It is important to note that the amendments are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues, only further clarify subject matter already present, and have been made only to expedite the prosecution of this case. In most cases, the amendments to the claims only clarified antecedent basis issues, which were a result of the cancellation of a number of claims. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 39-41 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,587,457 issued to Mikkonen (hereinafter "*Mikkonen*"). The Examiner rejects Claims 1-8, 12, 14-15, and 17-30 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* in view of U.S. Patent No. 6,256,300 issued to *Ahmed* et al. (hereinafter "*Ahmed*") and "Voice Service Internetworking for PSTN and IP Networks" to Hamdi, et al. (hereinafter "*Hamdi*"). The Examiner rejects Claims 31-33, 34-38, 42-49, 50-72, and 76-77 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* in view of *Ahmed*. The Examiner rejects Claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* in view of *Ahmed*, *Hamdi* and in further view of "Convergence Between Public Switching and the Internet" to Schoen et al. (hereinafter "*Schoen*"). The Examiner rejects Claims 13 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* in view of *Ahmed*, *Hamdi* and in further view of "Mobile IP and Security Issue: An Overview" to Perkins (hereinafter "*Perkins*").

Applicant notes that the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P.

§2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.¹ As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness.

As amended, Independent Claim 1 recites, in part, [a] traffic controller [that] is further operable to communicate with other wireless routers for soft handoff of the call and to communicate with a public switched telephone network (PSTN) gateway through the wireline network...and a virtual path generator operable to configure a wireless virtual path in the wireline network to a second wireless router for soft handoff processing for the call, wherein the virtual path is a label switched path (LSP).

These teachings are not found in *Mikkonen*. In contrast to the teachings of Independent Claim 1, *Mikkonen* discloses a method for connecting data flows. The invention relates to a method of supporting the quality of service (QoS) in packet data transmissions between a wireless terminal (MT), having data communication with a radio access network. (See Abstract of *Mikkonen*.) It appears that the Examiner is in agreement with this proposition, as reflected by his comments in the current Office Action.

Mikkonen further provides: "The radio access network comprises the operations for accomplishing data transmission between the wireless terminal MT and the core network 3 as well as for controlling wireless resources, for setting up and down wireless data flows or radio flows, for moving the connection from one control station to another (handover), and possibly also for compressing packets." (See *Mikkonen*, Column 5, lines 48-54.) However, providing a generic access network that is capable of assigning a call (via a handover) is not akin to a traffic controller that is operable to communicate with other wireless routers and to use a label switched path (LSP). For at least this reason, each of the limitations of Independent Claim 1 is not shown, taught, or suggested by *Mikkonen*.

Independent Claims 44, 50, 60, 64, and 76 recite a limitation that is similar, but not identical, to that identified above in the context of an LSP configuration. For at least this reason, these Independent Claims are allowable over *Mikkonen* and any of the other cited references of record.

¹ See generally M.P.E.P. §2143.

With respect to the first criterion of non-obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of making the combination.² Thus, the fact that the teachings of one reference (*Mikkonen*) would improve the teachings of any other reference (*Ahmed*, *Schoen*, or *Perkins*), as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Mikkonen* or in any other cited reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of the proposed modifications.³ The Examiner merely speculates that “it would have been obvious” to make the proposed combinations. The Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required by Federal Circuit case law.⁴ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁵

Furthermore, the Examiner is precluded from modifying the combined teachings of *Mikkonen*, *Ahmed*, *Schoen*, and *Perkins* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.⁶ The fact that the modification is possible or even advantageous is

² See M.P.E.P. §2143.01.

³ The Examiner is relying on “common knowledge” or “well known” art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

⁴ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not “evidence.” *Id.*

⁵ See M.P.E.P. §2145. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references.”); see also *In re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”)

⁶ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

not enough.⁷ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.⁸

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Mikkonen* and any of the references of record would not be capable of performing the operation required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Mikkonen* could provide a wireless router capable of offering any of the functions identified above; nor is there any disclosure relating to the other elements identified in the pending claims in the analysis provided supra. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Mikkonen-Ahmed*, *Schoen*, or *Perkins* combinations would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly in the tendered analysis provided by the Applicant. With no other supporting references that are combinable with *Mikkonen*, all of the claim limitations have not been taught or suggested by the Examiner's currently proposed combinations. Therefore, Applicant respectfully submits that all of the pending claims have been shown to be allowable, as they are patentable over all of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of the pending claims.

⁷ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

⁸ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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